

## REMARKS

Claims 36-65 are pending in the present application. New claim 65 was added in this response. No new matter was introduced as a result of the amendment. Favorable reconsideration is respectfully requested.

Claims 36 and 56 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action alleged that the limitation “wherein the reception of data packets to be detected and the characteristic data packets occurs parallel” recited in claim 36 and similarly in claim 56 was not described in the specification in such a way to reasonable convey to one skilled in the relevant art that the inventor, at the time of the application was filed, has possession of the claimed invention. Applicant respectfully traverses this rejection.

The present specification, page 9, second paragraph, discloses that a GSM frame transmitted by the GSM base station contains eight timeslots, each of which contains a data packet dp. The data packets transmitted by the GSM base stations BS2, such as the frequency correction data packet FB (characteristic data packet, FCCH data packet, Frequency Correction Burst), the synchronization data packet SB (the data packet which is to be detected, SCH data packet, Synchronization Burst) and the normal data packet are all subject to the same time pattern. On page 11, second-to-last paragraph, the present specification teaches that, as explained in Figure 5, both the FCCH data packet FB and the SCH data packet SB are used in parallel for synchronization. As a result, search speeds a significantly increased over known methods of doubling the number of FCCH data packets. Figure 5 illustrates under the exemplary embodiment that the FB (characteristic data packet) and SB (data packet to be detected) are received in parallel (see RHS of Figure).

In light of the above, Applicants continue to be concerned over the Advisory Action’s insistence on maintaining the §112 rejection. FIG. 5 clearly illustrates that the FCCH data packet FB and the SCH data packet SB are used in parallel for *synchronization* (which involves the transmission and receipt of signals). The present disclosure does not merely end at describing the search process, but also discloses the *receipt* of the packets as well. Starting from the LHS of the figure, a search is conducted in parallel over a number of frames, where the frequency correction data packet FB 11 is found and then matched with the synchronization data

packet 10 via an adjacent channel and provided to the mobile station in the same frame (FIG. 5, amended specification, page 12, last two paragraphs – page 13 first paragraph, see also page 15, third full paragraph).

Applicants submit that the rejection under 35 U.S.C. §112, first paragraph is improper. There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (MPEP 2163). The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims (MPEP 2163 IIA). Since the rejection fails to meet this burden, Applicants respectfully submit the rejection is improper. Withdrawal of this rejection is respectfully requested.

Claims 36-45 and 56-64 were rejected under 35 U.S.C. §102(b) as being anticipated by *Grimlund* (WO 94/29981). Claim 46 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Grimlund* (WO 94/29981) in view of *Ault et al.* (US Patent 5,754,542). Claims 47-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Grimlund* (WO 94/29981) in view of *Bruckert et al.* (US Patent 5,812,542). Applicant respectfully traverses these rejection. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not teach “switching, during interruption phases, the mobile station to reception of the data packets to be detected and transmitted by the second base station using the second transmission method, wherein the reception of data packets to be detected and the characteristic data packets occurs parallel” as recited in claim 36, and similarly recited in claims 47 and 56 (“simultaneous”).

As argued previously, *Grimlund* discloses a system and method where the characteristic data packet is received first (i.e., serially), processed, and then continues with obtaining the data packets to be detected (page 9, lines 19-25). *Grimlund* makes clear that the “make-before-break” configuration (1) maintains communication with the old base station(s), (2) establishes a new link during the idle part of the frame, and (3) establishes a new link, and then (4) synchronizes with the new link. Accordingly, *Grimlund* does not disclose every feature of the presently amended claims and is improper. Furthermore, in light of Applicant’s traversal of the rejection


under 35 U.S.C. §112, the claims are patentably distinguished from *Grimlund*. Withdrawal of the rejection is respectfully requested.

Additionally, new claim 65 recites the features of “switching, during interruption phases, the mobile station to reception of frequency correction packets transmitted by a second base station using a second transmission method; and switching, during interruption phases, the mobile station to reception of a synchronization packet transmitted by the second base station using the second transmission method, wherein the reception of synchronization burst and the frequency correction burst packets occurs parallel.” Clearly *Grimlund* does not teach this configuration. In addition, *Ault* and *Bruckert* fail to cure the deficiencies of *Grimlund*. As such, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is also improper. Withdrawal of the rejection is respectfully requested.

In light of the above, Applicants respectfully submit that claims 36-65 are both novel and non-obvious over the art of record. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-197) on the account statement.

Respectfully submitted,

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Dated: February 9, 2006